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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,717	03/16/2001	Edward G. Nicholl	3606-05-03	7982

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04/22/2004

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EXAMINER

VARGOT, MATHIEU D

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/810,717

Applicant(s)

NICHOLL ET AL.

Examiner

Mathieu D. Vargot

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17 and 20-27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 17 and 20-27 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

1. Claims 21 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 21, lines 1-2, "said crosslinking prepolymer" technically lacks antecedent basis and should be referred to as —said copolymerizable unsaturated prepolymer— as set forth in claim 17. Also, in claim 26, line 2, the prepolymer should be identified as it is set forth in claim 17 to avoid any possible confusion.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 20, 21, 23, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richart either alone or further in view of in view of European Patent Application 844,286 (see page 6, lines 8-14).

Richart is applied for reasons of record, the reference at best failing to disclose that 50-100% of the polyols used contain an active hydrogen moiety or an explicit disclosure that the unsaturated polyester necessarily contains a crystalline portion. First of all, Richart teaches making the polyesters using hexanediols (col. 3, lines 60-61) which are known and disclosed by applicant as polyols with an active H. Further, Richart uses many polyol and dicarboxylic acid moieties to make the polyester which are known to promote crystallinity, as set forth in applicant's specification and page 6, lines 8-14 of European —286. It certainly would have been obvious to pick and choose the

Art Unit: 1732

hexanediol disclosed by Richart as the polyol and therefor make the polyester using a polyol fraction which is 50-100% active hydrogen. Further, based on European -286, it is abundantly clear that many acids and polyols disclosed in Richart promote crystallinity in the final polyester. Hence, instant claim 17 is clearly obvious over Richart alone or in combination with European -286.

3. Claims 22, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richart in view of European Patent Application 844,286. Richart is applied for reasons of record, the primary reference failing to disclose using a photoinitiator. However, European -286 clearly teaches these in admixture with thermal curing agents when curing polyester powder coatings. It would certainly have been obvious for one of ordinary skill in the art to modify the article made by Richart with the incorporation of photoinitiators as taught by European -286 to facilitate a low temperature cure.

4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

In view of the amendment, the 102 has been dropped against claim 17. However, it submitted that the instant claims nevertheless are simply not allowable over the prior art. Applicant's comment that Richart fails to show the instant unsaturated polyester which is partially or wholly crystalline or has 50-100% of its hydroxyl functionality being supplied by active hydrogen polyols has been addressed in the rejection, supra. These limitations are either obvious from Richart alone, or obvious taking European -286 in combination with Richart. Simply because a reference does not explicitly teach certain

properties of resins used does not mean that the resins themselves do not have these properties. In essence, European -286 is a "teaching" reference concerning the use of a crystalline polyester in Richart. Applicant notes that Richart fails to provide an on-mold coating. First of all, applicant is claiming a product which would not "know" how it is molded, and hence the "on-mold" aspect would be immaterial to the patentability of the claims. Secondly, it would appear that the mold in Richart is not a closed mold until the fill resin is added—ie, when the coating is cured, it would appear that the mold in Richart is indeed an open one, or "on-mold" coating as opposed to "in-mold" coating (ie, employing a closed mold for the cure of the coating). At any rate, as already explained, such would not impart patentability to the claims. In the response, applicant discusses two additional references, European -286, which was applied against the claims, and Ortiz, which was not. At this point, Ortiz is considered to be cumulative with respect to the art applied. Applicant submits that European -286 is not applicable because the product is not integral as in the instant sense. However, it should be noted that European -286 is merely being relied upon to teach certain aspects which might not have been explicit in the disclosure of Richart or the use of photoinitiators. It is not being used to show structural characteristics such as noted by applicant. It is not even that clear that applicant is correct in assessing that European -286 does not show an integral article with a cured coating attached to a base resin, which in fact is taught in European -286. The fact that the reference applies the coating to an already existing article does not mean that the coating and article are not integral. Integral only means that two things are attached in some manner, and certainly would not be given the

Art Unit: 1732

interpretation set forth by applicant that the resins would cross the interface to some extent, such interpretation not even being supported by the instant specification.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni, can be reached on 571 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Application/Control Number: 09/810,717

Page 6

Art Unit: 1732

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
April 19, 2004

M. Vargot
Mathieu D. Vargot
Primary Examiner
Art Unit 1732

4/19/04